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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,966	09/08/1999	RICHARD J. DITZIK		9391

27058            7590            10/09/2002

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SAN DIEGO, CA 91902

EXAMINER
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KINCAID, LESTER G

ART UNIT	PAPER NUMBER
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2685  
DATE MAILED: 10/09/2002

28

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/391,966	DITZIK, RICHARD J.
Examiner	Art Unit	
Lester G. Kincaid	2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 03 September 2002.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 14,23,24,31 and 40-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 14,23,24,31 and 40-53 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____                                     |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/3/02 has been entered.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the methods of controlling a handset, including the steps recited in claims 14 and 44 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. **Claim 49** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form. Claim 49 requires that the "transmitting" and "receiving" steps be adapted to communication to/from a wireless cellular radio network, however the independent claim (44) requires those steps be for communication to/from the base unit - the limitation of which must remain in the dependent claim.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 14, 23, 24, 31, and 40-53** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding **claim 14**, the instant specification fails to provide for any specific control of the handset unit, except for the admission that "the handset may operate roughly equivalent to conventional cellular telephone handsets" (bottom of page 9 as numbered, 10 as counted, 11 as referred to by applicant) as it appears to be limited to the control of the base unit / notebook computer system, therefore it is considered unreasonable to believe that the inventor had possession of the claimed method at the time the application was filed. That is, the instant specification lacks any mention of a

"method of controlling a handset unit", a step of "executing control of said handset unit", that the "selecting a plurality of communication modes" (which is actually performed by the user of the base unit) is with any "coordination with said executing step", that the "controlling said plurality of communication modes" is "under control of said executing control step", that the "multiple functions of said handset unit appear roughly simultaneous in operation".

Regarding **claim 23**, the instant specification fails to provide for the "handset unit" to primarily be a "personal digital assistant device", but instead provides for the base to be a PDA.

Regarding **claim 41**, the instant specification fails to provide for the "handset unit" to be "adapted to access the Internet", but at most provides for the base to.

Regarding **claim 42**, the instant specification fails to provide for the "handset unit" to be "adapted to hands free speakerphone-like operation", but at most provides for the base to.

Regarding **claim 43**, the instant specification fails to provide for the "handset unit" to be "adapted to record and playback audio or video content", but at most provides for the base to.

Regarding **claims 50, 52, and 53**, the instant specification fails to provide for the "handset unit" to be adapted to "e-mail functions", "personal productivity functions", or "computer telephony functions" but at most provides for the base to.

Regarding **claim 44**, the instant specification fails to provide for any specific control of the handset unit, except for the admission that "the handset may operate

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roughly equivalent to conventional cellular telephone handsets" (as applied above to claim 14). Further, the specification fails to provide any details (e.g. microprocessor system using control program, data stored in memory and microprocessor system components), or that the "adapting", "transmitting", and "receiving" is "under control of said microprocessor system".

Regarding **claim 48**, the instant specification fails to provide for the "handset unit's voice and control functions are adapted to functions of an earset unit" as presently recited in **claim 48**.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 46 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 46 and 47 are recites the limitation "said adapting data step" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the

treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

10. **Claims 44, 45, 46, and 48** are rejected under 35 U.S.C. 102(e) as being anticipated by Åkerberg et al. (U.S. Patent 5,533,027).

As to **claim 44**, Åkerberg et al. disclose a system (Fig. 5) for controlling wireless communication functions of a handset (SMS / 5), producing the method comprising the steps of:

controlling the handset (SMS / 5) via microprocessor system located in handset, (see Fig. 16);

adapting handset unit to wireless communication functions and signals for relatively short distance wireless local networking with a base unit (SFS / 2) (see col. 5, lines 53-66), wherein information is relayed via RF communication functions to an external wide area network (Public Network / 1); and

transmitting and receiving wireless radio frequency information to/from base unit (SFS / 2), under control of the handset microprocessor system (27).

As to **claim 45**, Åkerberg et al. disclose everything claimed as applied above to claim 44, and further provide for networking functions with one or more other handset units (5b, 5c, 5d,...5n).

As to **claim 46**, (as best understood considering the indefiniteness cited above) Åkerberg et al. disclose everything claimed as applied above to claim 44, and further it is considered that a base unit would be connected to the Internet via some combination of wire or cable connections.

As to **claim 48**, Åkerberg et al. disclose everything claimed as applied above to claim 44, and it is further considered that the handset units voice and control functions are adapted to functions of an earset, as broadly claimed.

11. **Claims 14, 24, 40, 41, 44-51, and 53** are rejected under 35 U.S.C. 102(e) as being anticipated by Lintula et al. (U.S. Patent 5,884,190).

As to **claims 14, 44-49, and 53**, Lintula et al. disclose a handset unit (2) operated by a user, and method for controlling it, comprising:  
executing control of the handset unit accepting user inputs and generating processing outputs (inherent to all cellular telephones), the unit (2) being adapted for wireless communication with a base unit (1) a relatively short distance away, (see col. 4, lines 1-11) for the purpose of wireless relaying data to and from an external wide area network (see col. 3, lines 39-67);

selecting a plurality of computing and communication modes, (see col. 4, lines 12-19) including voice, data and conventional control (inherent to all computers after 1995) in coordination with the executing control step, wherein the user has the option to run the modes roughly simultaneously (inherent to all computers after 1995);

controlling to appear roughly simultaneous in operation (inherent to all computers after 1995); and

(inherently) causing to execute a plurality of programs under control of the executing control step. See Fig. 1.

As to **claims 24 and 51**, Lintula et al. further provide for the handset primarily being a cellular phone. See col. 3, lines 39-66.

As to **claims 40 and 50**, Lintula et al. further provide for the base unit primarily being a portable notebook-like computer system (1) with external communication capability, (inherently including e-mail) see Fig. 1.

As to **claim 41**, Lintula et al. further (inherently) provide for the unit being adapted to access the internet, (see Fig. 1).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 23, 31, 42, 43, and 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintula et al.

Lintula et al. disclose everything claimed as applied above to claim 14, however fail to recite each limitation, each of which were well known in the art at the time the invention was made, and would have been obvious modifications to the system of

Lintula et al. for the purpose of appealing to more users by increasing the features of the product in well known ways.

***Response to Arguments***

14. Applicant's arguments filed 9/3/02 have been fully considered but they are not persuasive.

Response may be found in the advisory action mailed 8/26/02.

***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lester G. Kincaid whose telephone number is (703) 306-3016. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

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**or faxed to:**

(703) 872-9314 (Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

LGK  
October 7, 2002



LESTER G. KINCAID  
PRIMARY EXAMINER